

Docket No. AB-164U

Remarks/Arguments

By way of the present amendment and pursuant to 37 C.F.R. §1.116, Applicants have canceled Claims 1-12, 15, and 18-22. The subject matter of canceled Claims 1-12, 19-22, and similar claims, will be pursued in a continuing application(s).

By way of the present amendment and pursuant to 37 C.F.R. §1.116, Applicants have also herein amended Claims 13 and 16 as indicated below, which claims as amended are in better form for consideration on appeal. Three (3) claims remain pending in the application: Claims 13, 16, and 17 of which Claims 13 and 16 are independent. Applicants respectfully request reconsideration of the three (3) pending claims in view of the comments below.

Claim Rejections - 35 U.S.C. § 102

Claims 13, 16, and 17 were rejected under 35 U.S.C 102(b) as being anticipated by Real (Pat. No. 5,649,936). The Examiner acknowledged (page 3, paragraph 3, of the Office Action) that the Real '936 patent does not disclose the use of macroelectrodes attached to the second cannula and after reviewing the '936 patent, Applicants agree with such findings. The Examiner has also considered the term *cannula* to apply to any tube or tube-like structure within which instruments or probes may be inserted (page 2, paragraph 2, of the Office Action). In the specification, a more specific definition for the term *inner cannula* is provided as "e.g., a cannula for placing a recording microelectrode or stimulating macroelectrode and/or a cannula for placing a lead." (see pages 14 and 15, paragraph [0128]). Furthermore, FIGS. 7A and 7B show an embodiment of an inner cannula 186 having stimulating macroelectrodes 188 attached to the inner cannula 186.

In view of the above, Applicants have disclosed the use of macroelectrodes attached to the second cannula, thus the limitation "wherein the second cannula includes a macroelectrode attached to the second cannula" found in dependent Claim 15 (which claim has been canceled) has been added to independent Claim 13. Likewise, the limitation "using the second cannula as a macroelectrode, wherein the macroelectrode is attached to the second

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cannula" found in dependent Claim 18 (which claim has been canceled) has been added to independent Claim 16.

In view of the above-described amendments to independent Claims 13 and 16, which adds to these amended independent claims an element not found in Real, the rejection of independent Claims 13 and 16 under 35 U.S.C 102(b) as being anticipated by Real (U.S. Pat. No. 5,649,936), has been overcome. Further, because Claim 17 is dependent upon Claim 16, the rejection of dependent Claim 17 under 35 U.S.C 102(b) as being anticipated by Real has also been overcome.

As now amended independent Claims 13 and 16 are not anticipated by Real and are now in condition for allowance.

Claim Rejections - 35 U.S.C. § 103

Claims 15 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Real in view of Sunde (EP 1062973A1). Applicants have hereby canceled Claims 15 and 18 as explained above. Further, by adding the limitation from Claim 15 to independent Claim 13 and by adding the limitation of Claim 18 to independent Claim 16, the claimed invention as a whole, as now presented by amended Claims 15 and 18, would not have been obvious to one of ordinary skill in the art at the time the invention was made. As pointed out above, the Examiner acknowledged (page 3, paragraph 3, of the Office Action) that the Real '936 patent does not disclose the use of macroelectrodes attached to the second cannula. As specified in the specification, Applicants have disclosed "a macroelectrode attached to the second cannula" which limitation is now part of amended independent Claims 13 and 16.

In view of the above, applicants respectfully request that a timely Notice of Allowance be issued in this case.

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The Examiner is invited to telephone the undersigned, Victoria A. Poissant, at his convenience should any issues remain after consideration and entry of this response, in order to permit early resolution of such issues.

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Respectfully Submitted,



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